

REMARKS

Applicant thanks the Examiner for his indication of allowable subject matter with regard to dependent claims 29-35. Claims 1, 11, 22, and 27 are amended to include the allowable subject matter respectively recited in now-cancelled claims 35, 29, 32, and 33. Claim 30 is amended purely to update its dependency. Claims 31 and 34 are rewritten in independent form including all of the recitations of their associated base claims. Moreover, as discussed in detail below, claims 1-10, 11, 22, and 27 are further amended to address the Examiner's concerns with regard to Section 101 and Section 112. Claims 1 and 34 are further amended to ensure proper antecedent basis in the now-combined claims. Claims 18-21 and 26 are cancelled without prejudice or disclaimer. Thus, as amended, each of pending claims 1-17, 22-25, 27, 30-31, and 34 are allowable. Accordingly, all claims are in immediate condition for allowance. Applicant respectfully submits that this amendment should be entered under rule 116 and that all claims should be passed on to issue.

In the Office Action, claims 1-10 were rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Claims 1-9 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 1-10, 11-17, 22-26, 29, 31-32, and 35 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Moreover, claims 1-3, and 7-10 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Pat. No. 6,967,964 to Svanbro et al. ("Svanbro") in view of U.S. Pat. No. 6,300,887 to Ie ("Ie").¹ Claims 4-6 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable by Svanbro in view of U.S. Pat. No. 6,032,197 to Birdwell et al. ("Birdwell") and U.S. Pat. No. 6,914,903 to Miyazaki ("Miyazaki").² Claims 11-27 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Svanbro in view of Birdwell. Claim 14 was rejected under 35 U.S.C. § 103(a) as allegedly being anticipated by Svanbro in view of Birdwell and Miyazaki. Applicant respectfully traverses the rejections.

¹ In the Office Action the Examiner indicated that the claims were allegedly anticipated. However the arguments made by the Examiner allege obviousness, not anticipation.

² In the Office Action, the Examiner rejected the claims under Section 102(b). However, Applicant assumes the Examiner intended to reject the claims under Section 103(a).

In view of the following arguments, all claims are believed to be in condition for allowance over the references of record. Therefore, this response is believed to be a complete response to the Office Action.³ Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicant expressly does not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

I. Claim Rejections – 35 U.S.C. § 101

In the Office Action, the Examiner maintained his rejection of claims 1-10 under 35 U.S.C. Section 101 as allegedly being directed to non-statutory subject matter. (Office Action, pages 2-3, 6-8.) In the rejection, the Examiner appears to have included discussion from the PTO's "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" for statutory subject matter under Section 101. (*Id.*) However, between the issuance of the previous non-final Office Action dated August 22, 2008 and of the instant Office Action, the Court of Appeals for the Federal Circuit specifically addressed the issue of statutory subject matter in In re Bilski, 2007-1130 (Fed. Cir. Oct. 30, 2008). While discussing the now-controlling "machine-transformation test" for determining whether a process constitutes statutory subject matter under Section 101, the Court stated that "[a] claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus." (*Id.*) Applicant respectfully submits that as amended, not only is claim 1 directed to a particular machine, but claim 1 is also patentable subject matter under 35 U.S.C. § 101 and therefore meets the Federal Circuit's new "machine-transformation test."

As amended, claim 1 recites at least one hardware device, namely "[a] packet header decompressor including a computing device and a storage space for maintaining a history, said decompressor configured to receive a packet, said packet comprising:" the recited details. (Emphasis added.) Thus, claim 1 is clearly tied to a particular machine(s) or apparatus, and is

³ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such assertions/requirements in the future.

therefore directed to statutory subject matter under Section 101, even under the “machine-transformation test.”

Accordingly, Applicants submit that claim 1, and claims 2-10 that depend therefrom, recite statutory subject matter under Section 101, and for at least the reasons stated above, the Examiner’s Section 101 rejection has been fully addressed and should be withdrawn.

II. Claim Rejections – 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 1-10 “as failing to comply with the written description requirement” and alleged that “claim 1 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” (Office Action, pages 8-9.) Specifically, the Examiner alleged that “there is no mention of a tangible computer readable medium in the specification.”

Although the specification does not include the exact phrase “a tangible computer readable medium,” Section 112 does not require exact word-for-word support in the specification for claimed elements. In contrast, as stated in the MPEP, “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement.” (MPEP 2163.02.)

Further, the specification does in fact provide adequate support for “a tangible computer readable medium.” For example, support may be found in the specification at least in Figure 1 and in paragraphs 15 through 17, which clearly describe “a storage space 116” including “headers 117” and “a storage space 120” including “packets 122” in the context of the disclosure. (Applicant’s Specification, paragraphs 15-17, Figure 1.) Moreover, the specification further states that “[the] computer program(s) . . . can be stored on one or more storage medium readable by the processor (including volatile and non-volatile memory and/or storage elements.)” (Specification paragraph 35.) At least these portions of the specification include support for “a tangible computer readable medium.” Accordingly “a tangible computer readable medium” is not new matter.

Moreover, to further prosecution, amended claim 1 no longer recites “a tangible computer readable medium,” and thus the issue is moot. For at least these reasons, the Examiner’s Section 112, first paragraph, rejection of claim 1 and claims 2-10 that depend therefrom have been fully addressed and accordingly should be withdrawn.

III. Claim Rejections – 35 U.S.C. § 112, Second Paragraph

A. “a first value associated with an uncompressed header...”

The Examiner rejected claims 1-10 under Section 112, second paragraph, and stated that:

both “a first value associated with an uncompressed header, configured for driving a second uncompressed header for said packet based on said uncompressed header” and “a second value associated with a third uncompressed header, configured for driving said uncompressed header based on said third uncompressed header” limitations are new and there is no support for them in the specification-the specification supports a first value associated with second uncompressed header and the second value associated with the third uncompressed header, and both value 1 and the second value are used to [derive] the uncompressed header. [Nowhere] in the specification there is support for a first value is being used to [derive a] second uncompressed header and nowhere in the specification there is support for the second value being used to [derive a] second uncompressed header. In addition, the new matter of claim 1 has made the limitations unclear.

(Office Action, page 9; Emphasis added.)

In the previous response, Applicant had renumbered the elements in claim 1 to be introduced in the numeric order. Applicant does not believe that the change in numbering affected the scope of the claims. Thus, Applicant respectfully disagrees with the Examiner’s assertion that the renumbering of the first, second and third headers of claim 1 added new matter. Moreover, Applicant further disagrees that the specification lacks support for the renumbered elements.

However, in accordance with the Examiner’s suggestion, claim 1 has been amended back to the former ordering, and now recites in part:

a compressed header comprising:

a first value associated with a second uncompressed header, configured for deriving an uncompressed header for said packet based on said second uncompressed header; and

a second value associated with a third uncompressed header, configured for deriving said uncompressed header based on said third uncompressed header

Moreover, claims 5 and 9 dependent from independent claim 1 are further amended to be in conformance with the amendments to claim 1.

As acknowledged by the Examiner in his rejection claim 1, as amended, complies with the requirements of Section 112, second paragraph. (Office Action, page 9.) Accordingly, as the Examiner's Section 112 rejections of claims 1-10 have been fully addressed, Applicant respectfully requests for the Examiner's Section 112 rejections of claims 1-10 to be withdrawn and for the claims to be passed on to issue.

B. "maintaining a history of uncompressed headers at the second network node"

The Examiner rejected claims 11, 22, and 26 because the recitation "maintaining a history of the most recently uncompressed headers at the second network node" allegedly "does not have any clear objective." (Office Action, page 10.) Applicants respectfully disagree with the Examiner's assertion, and direct the Examiner to an example from the specification, which states:

With reference to FIG. 8A, there is shown an exemplary decompressor storage space 800 containing received headers that have been decompressed 802. In one embodiment, storage space 800 can be allocated to maintain N decompressed headers 802. For example, the number N of stored headers can equal eight so that the decompressor storage space 800 maintains the eight most recently decompressed headers. The most recently decompressed headers 802 may not have consecutive sequence numbers since packets may be received out of order or may not be received at all. As shown in FIG. 8A, while header 810 is the oldest decompressed header in the storage space 800, header eight-hundred eleven, a later header, is absent from the list. Referring again to the delta values 702 of FIG. 7 with N equal to eight, a compressed packet header 700 can be decompressed by applying one of the delta values 702 to a corresponding one of eight preceding headers 602. Stated another way, an uncompressed header with sequence number s can be used to decompress headers (s + 1)

through (s + 8). Accordingly, stored header 810 in FIG. 8A can be used to decompress header eight-hundred eleven, and stored header 818 can be used to decompress headers eight-hundred nineteen through eight-hundred twenty-six.

(Specification, paragraph 32; See also Specification, paragraphs 16 and 24-27.) Accordingly, for at least the aforementioned reasons, “maintaining a history of the most recently uncompressed headers at the second network node” has a clear objective.

Moreover, the Examiner further alleged that “the phrase ‘the most recently’” is not specific and clear. (*Id.*) Although Applicant does not believe it to be necessary, each of claims 11, 22, and 26 are amended to recite maintaining “a history of uncompressed headers at the second network node, wherein said history contains a subset of the uncompressed packet headers,” without the phrase “the most recently.” Accordingly, as the claims have been clarified, this rejection has been fully addressed.

Thus, each of claims 11, 22, and 26 has a clear object and is also specific and clear. Accordingly, the Examiner’s Section 112 second paragraph rejections of claims 11, 22, and 26 are fully addressed and should be withdrawn.

III. Claim Rejections – 35 U.S.C. § 103

As indicated above, claims 1, 11, 22, 27, and 31 are amended to include subject matter indicated as being allowable by the Examiner, while additionally addressing the Examiner’s further suggestions relating to 35 U.S.C. Sections 101 and 112. Moreover, each of dependent claims 2-10, 12-17, 23-25, and 30 are allowable at least because they depend from one of allowable independent claims 1, 11, 22, or 27. Accordingly, as each of the pending claims recites allowable subject matter, the Examiner is respectfully requested to pass the claims on to issue.

CONCLUSION

In view of the above amendment, Applicant believes the pending application is in condition for allowance. Reconsideration and allowance are respectfully requested.

It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account No. 18-0013, under Order No. 65632-0527. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged against the aforementioned account.

Dated: May 18, 2009

Respectfully submitted,

Electronic signature: /Michael B. Stewart/
Michael B. Stewart

Registration No.: 36,018
RADER, FISHMAN & GRAUER PLLC
Correspondence Customer Number: 25537
Attorney for Applicant